

Remarks

The first paragraph of the specification has been amended to reflect the priority of the present application. This amended priority is consistent with the Supplemental Application Data Sheet submitted herewith.

Claims 1 and 353–371 are pending. Claims 2-352 have been cancelled without prejudice or disclaimer. Amended claim 1 and newly added claims 353–371 are directed to certain embodiments of the invention. Support for these claims is found in the specification at pages 1, 20, 31, and 240-243, as well as originally filed claim 170. Additional support is found throughout the specification. Accordingly, no new matter is introduced.

The Rejection of Claim 1 Under 35 U.S.C. § 101

Claims 1 has been rejected under 35 U.S.C. § 101 as claiming the same invention as that of claim 1 of U.S. Patent No. 5,994,391 (hereinafter, the ‘391 patent). In response, Applicants amended claim 1 as noted below.

Amended claim 1 differs from claim 1 of the ‘391 patent in several respects. For example, amended claim 1 now recites an oral pharmaceutical composition comprising a compound of formula (I) and a pharmaceutically acceptable carrier for delivering said compound of formula (I) to the small intestine by oral administration. Amended claim 1 also recites a daily dosage range not recited in claim 1 of the ‘391 patent. New claims 353-371 similarly differ in one or more respects from claim 1 of the ‘391 patent.

It is well established that claims of the “same invention” under 35 U.S.C. § 101 are directed to

...identical subject matter. Thus the invention defined by a claim reciting "halogen" is not the *same* as that defined by a claim reciting "chlorine," because the former is broader than the latter...[P]robably the only objective test, for "same invention" is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention...


In re Vogel, 422 F.2d 438, 164 (CCPA 1970) [emphasis in original]. The objective test announced in *In re Vogel*, termed the "cross-readability" test, has been reaffirmed by the Federal Circuit as being the method of determining whether "same invention" type double patenting exists. *Shelcore, Inc. v. Durham Industries, Inc.*, 745 F.2d 621, 223 USPQ 584 (Fed. Cir. 1984).

In view of the foregoing amendments, it is clear that now pending claims 1 and 353-371 do not "cross-read" with the claims of the '391 patent. As such, Applicants respectfully request withdrawal of the same-claim double patenting rejection under U.S.C. § 101 and also request a written indication of the same together with allowance of the pending claims.

Respectfully submitted,

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Attachment:

Supplemental Application Data Sheet